

## REMARKS

Favorable reconsideration and allowance of this application are requested.

### **1. Discussion of Claim Amendments**

The pending claims herein are substantively identical to those presented with the Preliminary Amendment dated June 15, 2006, with the exceptions being that the informality in claim 4 helpfully noted by the Examiner has been corrected and the preamble expressions of claims 3 and 8 have been revised for the purpose of conformity. A self-evident typographical error has also been correct in claim 17.

Therefore, following entry of this amendment, claims 1-22 will remain pending herein for consideration.

### **2. Response to 35 USC §103(a) Rejections**

Claims 1-9 and 12-22 attracted a rejection under 35 USC §103(a) as allegedly being unpatentable over Overbeek et al (GB 2362387) in view of Pears et al (WO 93/24551). Applicants respectfully disagree.

At the outset, applicants wish to emphasize that the presently claimed invention requires careful selection of parameters that produce compositions with improved stain resistance. Thus, as described in the originally filed specification at page 2, lines 23-25, the present applicants have found that by careful tailoring of polyurethane and vinyl polymer components, an aqueous coating composition can be provided with offers unexpectedly good stain resistance. Therefore, while some claimed components may in and of themselves be known individually in the art, what is unknown that the combination of specific claimed components in the specific proportions can yield such advantageous stain-resistant compositions as provided by the presently claimed invention.

What is required by an analysis under 35 USC §103(a) is thus more than merely "cherry picking" words or phrases from one prior art reference and combining it with another. As the Supreme Court observed in *KSR International Co. v. Teleflex Inc.*:<sup>1</sup>

"...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (emphasis added)

As will become evident from the discussion below, when the prior art is analyzed properly according to the standards of *Graham v. John Deer Co.*<sup>2</sup> it must therefore be concluded that the presently claimed invention is patentably *unobvious*.

Turning attention to the substantive issues, the Examiner asserts that an ordinarily skilled person would find it obvious to import features from Pears et al into Overbeek et al to arrive at the claimed invention because both such references are in

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<sup>1</sup> 550 U.S. 398, 82 USPQ2d 1385, 1396 (2007)

<sup>2</sup> 383 U.S. 1, 148 USPQ 459 (1966).

the field of polyurethane (PU) vinyl hybrid dispersions and because Pears et al teaches advantages in using ring structures such as cyclohexanol dimethanol.

The field of PU-vinyl dispersions is however a very generic class comprising a large number of documents. Why then would an ordinarily skilled person starting with just the content of Overbeek et al be motivated to cross-reference Pears, rather than any of the other many documents in such a broadly defined generic field of endeavor? They simply would not. The alleged advantages of cyclohexanol dimethanol are not apparent from Overbeek et al alone. It is therefore only with advance knowledge of the presently claimed invention (the target to be achieved) that one might possibly select Pears et al and then import some of its teaching into Overbeek et al. This would of course be impermissible hindsight.<sup>3</sup>

In fact a reader of Overbeek et al would be actively deterred from modifying the compositions described therein. In this regard, applicants note that the passage on page 1, lines 13 to 29 of Overbeek et al discusses how a delicate balance of properties has been found to solve the problem that were addressed. An ordinarily skilled person is therefore taught *not* to upset such delicate balance, especially in relation to hardness versus block resistance. An ordinarily skilled person thus has a disincentive to import any feature from other prior art and is particularly not motivated at all to modify the hard components of Overbeek et al (such as with the ring structures of Pears et al as asserted by the Examiner).

Further reasons for an ordinarily skilled person having knowledge of Overbeek et al to ignore Pears et al is that Overbeek et al describes systems which are free of

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<sup>3</sup> The Federal Circuit regards hindsight as an insidious and powerful phenomenon and is a tempting, but forbidden zone in the inquiry of addressing the statutory obviousness standard. See, e.g., *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337 (Fed. Cir. 1985) and *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985).

coalescing solvent whereas Pears describes hybrids that can use solvent (see Pears et al at page 20 lines 1-2.)

A similar rationale applies when considering the reverse combination. Specifically, an ordinarily skilled person having knowledge of Pears et al would be deterred from selecting features from Overbeek et al to arrive at the presently claimed invention. The compositions of Pears et al are even more different from those of the presently claimed invention, thereby making the combination of features necessary to arrive at the same even more implausible than when starting with Overbeek et al as the primary reference.

For these reasons therefore the present claims are all patentably unobvious over any combination of Overbeek et al and Pears et al.

Grandhee (USP 6342558) was combined with Overbeek et al and Pears et al to reject claims 10-11 under 35 USC §103(a). In this regard, the comments above with respect to Overbeek et al and Pears et al are equally germane here as Grandhee fails to cure the noted deficiencies. Thus, pending claims 10-11 are similarly unobvious over the combination of Overbeek et al, in view of Pears et al and Grandhee.

Withdrawal of all rejections advanced under 35 USC §103(a) is therefore in order.

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**3. Fee Authorization**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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